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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,068	10/04/2004	Stanley F Barnett	21075YP	5599
<div>210                      7590                      10/01/2007</div> <div>MERCK AND CO., INC</div> <div>P O BOX 2000</div> <div>RAHWAY, NJ 07065-0907</div>				
<div>EXAMINER</div> <div>SUTTON, DARRYL C</div>				
<div>ART UNIT                      PAPER NUMBER</div> <div>1609</div>				
<div>MAIL DATE                      DELIVERY MODE</div> <div>10/01/2007                      PAPER</div>				

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/510,068

Applicant(s)

BARNETT ET AL.

Examiner

Darryl C. Sutton

Art Unit

1609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/20/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 7, 11, 15, 19, 23, 27, 31, 38 is/are pending in the application.
- 4a) Of the above claim(s)    is/are withdrawn from consideration.
- 5) ☐ Claim(s)    is/are allowed.
- 6) ☐ Claim(s)    is/are rejected.
- 7) ☐ Claim(s)    is/are objected to.
- 8) ☒ Claim(s) 1-4, 7, 11, 15, 19, 23, 27, 31 and 38 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on    is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No.   .
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>  </u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                           | 5) <input type="checkbox"/> Notice of Informal Patent Application                           |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>  </u> | 6) <input type="checkbox"/> Other: <u>  </u>  |

### DETAILED ACTION

Applicant's election without traverse of Group I, claims 1-4, 7, 11, 15, 19, 23, 27, 31 and 38 in the reply filed August 6, 2007 is acknowledged. Claims 5-6, 8-10, 12-14, 16-18, 20-22, 24-26, 28-30 and 32-37 and 39-55 are cancelled.

Upon review of the claims elected in Group I, further restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 6, claim(s) 11,15 and 38, drawn to a method for treating cancer by administering an inhibitor of the activity of Akt1 and Akt2 which is dependent on the presence of the PH domain of Akt1 and Akt2.

Group 7, claim(s) 19 and 23, drawn to a method for treating cancer by administering an inhibitor of the activity of Akt1 and Akt2 which is dependent on the presence of the Hinge domain of Akt1 and Akt2.

Group 8, claim(s) 27 and 31, drawn to a method for treating cancer by administering an inhibitor of the activity of Akt1 and Akt2 which is dependent on the presence of the PH domain and Hinge domain of Akt1 and Akt2.

Claim(s) 1-4 and 7 link(s) inventions 6, 7 and 8. The restriction requirement between the linked inventions is **subject to** the nonallowance of the linking claim(s), 1-4 and 7.

Upon the indication of allowability of the linking claim(s), the restriction requirement as

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to the linked inventions **shall** be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104 **Claims that require all the limitations of an allowable linking claim** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

The inventions listed as Groups 6, 7 and 8 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The methods as claimed are drawn to the inhibition of different species of molecules. In the methods as claimed, molecules that will be inhibited are dependent on the presence of distinct domains. Inhibitors which are dependent on the PH domain, the Hinge domain, and which are dependent on both domains inhibit separate and distinct molecules. Therefore, there is no common inventive concept, and no unity of invention.

This application contains claims directed to more than one species of the generic inventions. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows: inhibitors of isoforms of Akt1 and Akt 2 which are dependent on the PH domain, the Hinge domain or both. Inhibitors which are dependent on the PH domain, the Hinge domain, and which are dependent on both domains inhibit separate and distinct molecules. There is no overlap in the molecules inhibited by the three types of inhibitors.

Applicant is required, in reply to this action, to elect a single species of inhibitor of Akt1 and Akt2 to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

If an election is made of Group 6, then an election of a single species of inhibitor of Akt 1 and Akt 2 that is dependent on the PH domain must also be made.

If an election is made of Group 7, then an election of a single species of inhibitor of Akt1 and Akt 2 that is dependent on the Hinge domain must also be made.

If an election is made of Group 8, then an election of a single species of inhibitor of Akt1 and Akt2 that is dependent on both the PH and Hinge domain must also be made.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).


### **Conclusion**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darryl C. Sutton whose telephone number is (571)270-3286. The examiner can normally be reached on M-Th from 7:30 AM to 4:45 PM and Fr from 7:30 AM to 4:45 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Stucker, can be reached on M-Th from 7:30 AM to 4:30 PM at (571)272-0911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

DCS



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9/28/07  
ARDIN H. MARSCHEL  
SUPERVISORY PATENT EXAMINER